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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

PREBILIC, PAUL B

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 08/20/2004

27

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/418,505

Applicant(s)

KANIA ET AL.

Examiner

Paul B. Prebilio

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-25, 34-44, 47-50 and 54-96 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-25, 34-44, 47-50 and 54-96 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/25/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on June 18, 2004 has been entered.

Information Disclosure Statement

The information disclosure statement filed June 25, 2004 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. For this reason, the foreign language document citations without an explanation or translation have been struck from the PTO-1449 form.

Claim Objections

Claims 23, 44, and 47-49 are objected to because of the following informalities: In claim 23, line 3, claim 44, line 3, claim 47, line 3, claim 48, line 3 and claim 49, line 4, the use of "comprising" for the covering is confusing at this point in the claim because the language "covering comprising" or an equivalent thereof was used previously in the claim. For this reason, the Examiner suggests

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changing "comprising" to ---further comprising--- in order to overcome this objection. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 23-25, 34-44, 47-50, and 54-96 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In response to the Applicant's assertion that the new language of "substantially air-tight seal on the limb" avoids the prior art, the Examiner asserts that "substantially" is a broad term. *In re Nehrenberg*, 126 USPQ 383 (CCPA 1960) and see MPEP 2173.05(b) which is incorporated herein by reference. The specification fails to provide some standard for measuring that degree. Therefore, one of ordinary skill would not know what degree of "air-tight" would fall within the claim scope and what would not. The controlling case law appears to be that of *In re Mattison*, 184 USPQ 383 (CCPA 1960). It states:

We are not persuaded by the board's reasoning that one skilled in the art would not be able to determine the scope of the claimed invention in terms of a specified percentage value. General guidelines are disclosed for a proper choice of the substituent Ep together with a representative number of examples. (emphasis added here)

The Board of Appeals was reversed because there were general guidelines as to what constituted a substantial increase. This is not the situation

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here where there are no guidelines in the specification, and the prior art does not give one a clear picture as to what constitutes "substantially air-tight" and what does not. This is a critical and defining limitation of the claim and it must be clear as to what falls within its scope.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24, 25, 34-37, 42, 44, 48, 54, 58, 60, 62, 67, 72, 76, 78, 80, and 96 are rejected under 35 U.S.C. 102(b) as being anticipated by Lerman (US 4,635,626). Lerman anticipates the claim language where polymeric material is the polyester or rubber foam and it is on the inside of the outer fabric, the docking means as claimed is met by the casting tape of Lerman that is a type of strap as claimed and the terminology "substantially air-tight" is considered broad such that any material that impedes airflow somewhat falls within its scope; see the figures and columns 3 and 4.

With regard to claim 37, Tricot is a warp-knitted fabric, and thus, it is considered to be a type of fiber-on-end fabric due to the loops thereof and it is considered to be non-woven because it is knitted not woven.

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With regard to claim 42, the gel is a broad term in the art such that the polyester or rubber layer is considered to be a gel to the extent that this term is limiting.

Claims 23-25, 34, 35, 37, 38, 41-44, 47-50, 54-62, 65-68, 71-80, 83-86, 89, 90, and 93-96 are rejected under 35 U.S.C. 102(b) as being anticipated by Kania (US 5,603,122).

With regard to the claims, the effective filing date is no earlier than October 15, 1999 due to the new subject matter added to the claims. Therefore, Kania constitutes a statutory bar against the present claims.

Kania discloses a looped nylon (see column 4, line 38 and column 5, line 13) which constitutes a fabric as claimed. This fabric can adhere to hooks of hook and loop fastening systems because of the loops presented by this fabric. Therefore, the docking means as claimed is met by the looped nylon because looped nylon is the loop portion of VELCRO or hook and loop fasteners.

The sock of Kania can be coated in the inside thereof with a polymeric material as required by the claim language; see column 5, line 19 to claim 6, line 24.

The Examiner asserts that the looped nylon or Tricot nylon constitutes (see column 4, lines 65-67) a fiber-on-end fabric to the extent required by the present claim language. For this reason, the claim language is fully met.

The sock of Kania is considered "substantially air-tight" to the extent that this language can be given weight for the reasons mentioned earlier.

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With regard to claims 57 and 75, urethane is believed to be disclosed by the incorporated materials of column 5, lines 42-59.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 39, 40, 69, 70, 87, and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kania (US 5,603,122) in view of Handel (US 5,263,990).

Kania meets the claim language except for thicker closed end as claimed.

However, Handel teaches that it was known to make the cushion thicker at the closed end; see Figure 2 and element (22). Therefore, it is the Examiner's position that it would have been considered prima facie obvious to make the closed end cushion of Kania thicker for the same reasons that Handel does the same and in order to put the greatest cushion where the greatest force is present.

Regarding claims 40, 70, and 88, the claimed thicknesses are not compared to each other such that only an uneven distribution of polymeric material is required. Since Handel teaches an uneven distribution of polymeric material, the claim language is rendered obvious.

Claims 63, 64, 81, 82, and 91-92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kania (US 5,603,122) alone. Kania meets the claim

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language except for the dimensions or proportions as claimed. However, differences in size or proportion are prima facie obvious over the prior art unless such size or proportions are shown to be critical and unobvious.

In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir.1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Response to Arguments

Applicant's arguments filed June 18, 2004 have been fully considered but they are not persuasive.

In particular, the declaration under 37 CFR 1.132 filed June 18, 2004 is insufficient to overcome the rejection of claims 23-25, 30, 31, 33-37, 44, 46, 48-51, and 53 based upon Lerman as set forth in the last Office action because: (1) the declaration evidence is based upon a prototypical embodiment and not an embodiment that is clearly relevant in scope to the present claims, (2) the special definition given herein for the new terminology "substantially air-tight" does not limit the claim scope since it was not explicit or implicit with the original disclosure, (3) the evidence of paragraph 6 is anecdotal and not objective evidence such that it has little probative value, and (4) the prototype is of a significantly narrower embodiment than that of the claimed invention such that it has no clear nexus to the claimed invention.

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Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for this Technology Center is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.



Paul Prebilic
Primary Examiner
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